

REMARKS

Upon entry of the presently made amendments, claims 34-39 and 41 will be pending. Claim 42 has been canceled without prejudice.

Claim 34 has been amended to recite a breast cancer cell or a bone cancer cell and claim 36 has been amended to recite a breast cancer cell. Support for these amendments is found in the specification as filed at least at page 6, lines 22-25.

Claim 37 has been amended to recite breast cancer tissue or bone cancer tissue and claim 39 has been amended to recite bone tissue. Support for these amendments is found in the specification as filed at least at page 6, lines 22-25.

Claim 41 has been amended to recite that the estrogen-related condition is breast cancer or bone cancer. Support for this amendment is found in the specification as filed at least at page 7, line 5.

No new matter has been added.

Applicants reserve the right to prosecute the subject matter of any previously or currently canceled, withdrawn or amended claim or any other unclaimed subject matter in one or more continuation, divisional or continuation-in-part applications.

I. **Rejection of Claims 34, 35, 37 and 38 **Under 35 U.S.C. § 112, First Paragraph****

Claims 34, 35, 37 and 38 are rejected under 35 U.S.C. § 112, first paragraph, for allegedly lacking enablement. In particular, the Examiner has acknowledged that the specification is enabling for breast and osteosarcoma cancer cells, but has stated that the specification does not reasonably provide enablement for other types of cells.

Without acquiescing in the rejection and solely to expedite prosecution of the present application, Applicants have amended claim 34 to recite a breast cancer cell or a bone cancer cell and have amended claim 37 to recite breast cancer tissue or bone cancer tissue. Applicants note that claims 36 and 39 have been amended to recite a breast cancer cell and bone tissue, respectively. As acknowledged by the Examiner, Applicants respectfully submit that the amended claims are reasonably enabled by the data set forth in the specification in connection with breast cancer cells and osteosarcoma (the most common type of malignant bone cancer) cells.

Accordingly, Applicants respectfully submit that the rejection of claims 34, 35, 37 and 38 under 35 U.S.C. § 112, first paragraph, has been overcome and should be withdrawn.

II. Rejection of Claims 41 and 42
Under 35 U.S.C. § 112, First Paragraph

Claims 41 and 42 have been rejected under 35 U.S.C. § 112, first paragraph, for allegedly lacking enablement. In particular, the Examiner has acknowledged that the specification is enabling for treating breast and osteosarcoma cancer cells (bone), but has stated that the specification does not reasonably provide enablement for treating other claimed disorders.

Without acquiescing in the rejection and solely to expedite prosecution of the present application, Applicants have amended claim 41 to recite that the estrogen-related condition is breast cancer or bone cancer. As acknowledged by the Examiner, Applicants respectfully submit that the amended claims are reasonably enabled by the data set forth in the specification in connection with breast cancer cells and osteosarcoma cells.

Accordingly, Applicants respectfully submit that the rejection of claims 41 and 42 under 35 U.S.C. § 112, first paragraph, has been overcome and should be withdrawn.

III. Rejection of Claims 37 and 38
Under 35 U.S.C. § 112, First Paragraph

Claims 37 and 38 have been rejected under 35 U.S.C. § 112, first paragraph, for allegedly failing to comply with the written description requirement. In particular, the Examiner has stated that the term “ER- β in tissue expressing” does not specify or give the possible tissues of ER- β .

Without acquiescing in the rejection and solely to expedite prosecution of the present application, Applicants have amended claim 37 to recite breast cancer tissue or bone cancer tissue. Applicants respectfully submit that these tissues are adequately described in the specification as filed.

Accordingly, Applicants respectfully submit that the rejection of claims 37 under 38 U.S.C. § 112, first paragraph, has been overcome and should be withdrawn.

Conclusion

No fee is believed to be due in connection with this response other than that due in connection with the Petition for Extension of Time; however, should the USPTO determine that any additional fee is required, Applicants hereby authorize that the required fee be charged to Jones Day Deposit Account No. 50-3013.

Respectfully submitted,

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Date: August 10, 2007

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